no active game being played on the gaming device while not indicating a particular prize. The moveable object comprises at least one moveable object symbol. A controller is provided that is in communication with at least one controller selectable object. The controller selectable object comprises at least one controller selectable object symbol that is substantially similar in appearance to the moveable object. The controller selectable object may be displayed to the player and provides an illusion to the player that the controller selectable object is the moveable object. A game display is also provided and may be in communication with the controller. The game display is configured to display a display symbol in at least one display position. A game outcome at least partially depends on the display position of the display symbol.

2. Rejection of claim 56 under 35 USC §102(b) as being anticipated by Murray et al. (GB 2387009A).

Claim 56 stands rejected under 35 USC §102(b) as being anticipated by Murray et al. Applicants respectfully traverse the rejection.

Independent claim 56 has been amended to include the requirement that the moveable mechanical display does not indicate a particular prize when no active game is being played on the gaming device. Murray et al. clearly indicates that "… when no user is playing the game a timing mechanism … cause the wheels to rotate and stop in the manner of pseudo-games …" (Abstract and page 4, lines 17-18); "… wherein certain … of all possible symbol arrays indicate a prize condition … in the nature of a pseudo-game … (page 1, lines 22-24). Murray et al. continually refers to the "playing of pseudo-games by the machine itself …" (when no user is playing the game), clearly indicating that a possible prize is identified as part of the pseudo-game.

Since Murray et al. actually teaches away from and does not disclose all required elements of Applicants' claimed invention, Applicants submit that claim 56 (as currently amended) is not anticipated and respectfully request withdrawal of the 35 USC §102(b) rejection.

3. Rejection of claim 81 under 35 USC §103(a) as being obvious over Schulze (U.S. Patent No. 5,785,316) in view of Murray et al. (GB 2387009A).

Claim 81 stands rejected under 35 USC §103(a) as being obvious over Schulze in view of Murray et al. Applicants respectfully traverse the rejection.

The Office contends that it would have been obvious to include a controller in Schulze's gaming device based on the teachings of Murray et al., and that, as a result, Schulze's "mechanical display would not have indicated any particular prize." Applicants respectfully dispute this conclusion by the Office since Murray et al. teaches "caus(ing) the wheels (of a gaming device) to rotate and stop in the manner of pseudo games … when no user is playing the game" and there is no suggestion or disclosure in Murray et al. to provide one of ordinary skill in the art with the incentive or desire to change the teachings of Murray et al. to arrive at Applicants' claimed invention, namely, a method directed to moving the mechanical display, where the mechanical display does not indicate a particular prize when no active game is being conducted.

Schulze emphasizes game play throughout its disclosure: **col 2:59-60** ("… playing bodies determining the symbol combination at the end of a game …"); **col 4:44-45** and **51-60** ("… drums 5 are stopped …"; "… spheres provided with symbol identifications … represent the result of the game …"; and "… control device uses this information to evaluate the result of the

game … when a specific symbol combination appears …"); and all independent claims (1 and 20-25) in **col 5-10** referring to "… adapted to indicate a score …"

Similarly, Murray et al. teaches that "… when no user is playing the game a timing mechanism … cause the wheels to rotate and stop in the manner of pseudo-games …" (Abstract and page 4, lines 17-18); "… wherein certain … of all possible symbol arrays indicate a prize condition … in the nature of a pseudo-game …" (page 1, lines 22-24). Throughout Murray et al., the "playing of pseudo-games by the machine itself …" (when no user is playing the game) is referred to.

Even if the teachings of Murray et al. and Schulze were to be combined, one of ordinary skill in the art would have no incentive to modify the gaming device of Schulze as suggested by the Office. Indeed, the resultant combination of the teachings of both cited references would simply result in a gaming device where the wheels rotate and stop in a position corresponding to a game result, but when no user is playing the game. Both Murray et al. (Abstract; page 4: lines 17-18; and page 1: lines 22-24, for example) and Schulze (col 2:59-60; col 4:44-45 and 59-60, for example) teach the display of symbols or objects in the context of a prize condition or prize identification, in direct contrast with Applicants' claimed invention of the moving mechanical display not indicating a particular prize when no active game is being conducted.

Applicants submit that Schulze or Murray et al., either alone or in combination, does not disclose or suggest all of the elements required by Applicants' claimed invention. Accordingly, Applicants respectfully request withdrawal of the 35 USC §103(a) rejection.

4. Rejection of claims 82 and 96 under 35 USC §103(a) as being obvious over Schulze (U.S. Patent No. 5,785,316) in view of Murray et al. (GB 2387009A) and further in view of Rivero (U.S. Patent No. 4,871,171).

Claims 82 and 96 stand rejected under 35 USC §103(a) as being obvious over Schulze in view of Murray et al. and further in view of Rivero. Applicants respectfully traverse the rejection.

Schulze discloses a money operated slot machine and emphasizes game play throughout its disclosure: **col 2:59-60** ("... playing bodies determining the symbol combination at the end of a game ..."); **col 4:44-45** and **51-60** ("... drums 5 are stopped ..."; "... spheres provided with symbol identifications ... represent the result of the game ..."; and "... control device uses this information to evaluate the result of the game ... when a specific symbol combination appears ..."); and all independent claims (1 and 20-25) in **col 5-10** referring to "... adapted to indicate a score ..."

Murray et al. teaches that "... when no user is playing the game a timing mechanism ... cause the wheels to rotate and stop in the manner of pseudo-games ..." (Abstract and page 4, lines 17-18); "... wherein certain ... of all possible symbol arrays indicate a prize condition ... in the nature of a pseudo-game ..." (page 1, lines 22-24). Throughout Murray et al., the "playing of pseudo-games by the machine itself ..." (when no user is playing the game) is referred to.

Rivero appears to disclose a lottery game system involving a rotating container (cage) that simulates random selection of a numbered ball.

The Office contends that it would have been obvious to replace Shulze's rotating drum with a rotating cage-type containment means similar to Applicants' claimed invention. Applicants rely upon the discussion presented above (Section 3) regarding claim 81 (from which

claim 82 is dependent) to address the issue of non-obviousness regarding the Office's citation of Schulze in view of Murray et al. and further in view of Rivero, since none of Schultze, Murray et al. or Rivero, either alone or in combination, discloses or suggests all of the elements required by Applicants' claimed invention. For the same reasons, Applicants submit that claim 96 (now amended) is not obvious over Schulze in view of Murray et al. and further in view of Rivero.

Applicants further submit that claims 97-106 (dependent upon amended claim 96) similarly would not be obvious over Schulze in view of Murray et al. and further in view of Rivero.

Accordingly, Applicants respectfully request withdrawal of the 35 USC §103(a) rejection.

5. Rejection of claims 56-66, 80-82 and 96 under 35 USC §103(a) as being obvious over Rivero (U.S. Patent No. 4,871,171) in view of Murray et al. (GB 2387009A).

Claims 56-66, 80-82 and 96 stand rejected under 35 USC §103(a) as being obvious over Rivero in view of Murray et al. Applicants respectfully traverse the rejection.

Since independent claims 56 and 96 have been amended (to include the limitation that the moveable mechanical display does not indicate a particular prize during a non-game mode), Applicants submit that Murray et al. or Rivero, either alone or in combination, does not disclose or suggest all of the elements required by Applicants' claimed invention (including the corresponding dependent claims, i.e., claims 57-65, 67-80, 97-101 and 102-106).

Although independent claim 81 has not been amended, Applicants submit that Rivero offers no additional basis for obviousness compared to Shulze (in view of Murray et al.), as presented previously in Section 2.

The Office suggests that it would have been obvious to include a controller in Rivero's gaming device based on the teachings of Murray et al., and that, as a result, Rivero's "cage-like display would not have indicated any particular prize." Applicants respectfully dispute this conclusion by the Office since Murray et al. teaches "caus(ing) the wheels (of a gaming device) to rotate and stop in the manner of pseudo games … when no user is playing the game" and there is no suggestion or disclosure in Murray et al. to provide one of ordinary skill in the art with the incentive or desire to change the teachings of Murray et al. to arrive at Applicants' claimed invention, namely, a method directed to moving the mechanical display, where the mechanical display does not indicate a particular prize when no active game is being conducted.

Murray et al. teaches that "… when no user is playing the game a timing mechanism … cause the wheels to rotate and stop in the manner of pseudo-games …" (Abstract and page 4, lines 17-18); "… wherein certain … of all possible symbol arrays indicate a prize condition … in the nature of a pseudo-game …" (page 1, lines 22-24). Throughout Murray et al., the "playing of pseudo-games by the machine itself …" (when no user is playing the game) is referred to.

In addition, Rivero appears to disclose a lottery game system involving a rotating container (cage) that simulates random selection of a numbered ball (with symbols) and presentation of a prize corresponding to a winning combination of symbols. Rivero makes reference to winning combinations of symbols corresponding to a prize, consolation prizes, winning sets (of symbols), etc.; however, there is no suggestion or disclosure in Rivero that addresses activities when no active game is being played, nor that the game display indicates anything other than a prize related activity.

Accordingly, Applicants respectfully request withdrawal of the 35 USC §103(a) rejection.

6. Rejection of claim 79 under 35 USC §103(a) as being obvious over Rivero (U.S. Patent No. 4,871,171) in view of Murray et al. (GB 2387009A) and further in view of Travis et al. (U.S. Patent No. 5,380,007).

Claim 79 stands rejected under 35 USC §103(a) as being obvious over Rivero in view of Murray et al. and further in view of Travis et al. Applicants respectfully traverse the rejection.

Since claim 79 (via claim 56) has been amended (as discussed in Section 2) and the merits of the rejection over Rivero in view of Murray et al. have been addressed in Section 5, Applicants submit that Travis et al. offer no additional basis for rejection (other than the disclosure of video images), and that Rivero, Murray et al. or Travis et al., either alone or in combination, does not disclose or suggest all of the elements required by Applicants' claimed invention. Accordingly, Applicants respectfully request withdrawal of the 35 USC §103(a) rejection.

7. Rejection of claims 81-95 under 35 USC §112, second paragraph, as being indefinite.

Claim 81 (and corresponding dependent claims) stand rejected under 35 USC §112 for insufficient antecedent basis. Applicants respectfully traverse the rejection.

Applicants submit that amended claim 81 now provides proper antecedent basis for a "gaming device" and respectfully request withdrawal of the 35 USC §112 rejection.

8. Allowable Subject Matter

Claims 67-78, 83-95 and 97-106 stand objected to as being dependent upon a rejected base claim. However, the Office has indicated that the claims would be allowable if rewritten in

independent form including all of the limitations of the base claim and related intervening claims.

Applicants have presented three new independent claims to address the allowable subject matter as indicated by the Office. Claim 67 has been incorporated into claims 65 and 56 (from which it was dependent) as **new claim 107**. Claim 83 has been incorporated into claim 81 (from which it was dependent) as **new claim 108**. Claim 97 has been incorporated into claim 96 (from which it was dependent) as **new claim 109**.

8. Notice of Non-Compliant Amendment

Applicants received a Notice of Non-Compliant Amendment (37 CFR §1.121) in the same mailing as the outstanding office action. The notice referred to missing claims and improper identification of figures. However, this notice is actually in reference to U.S. Serial No. **10/633,179**, and not related to the present application: 10/663,179. Applicants have determined this error by examining the "image file wrapper" section in Public PAIR for the Application. Please remove the items dated July 11, 2006 and July 24, 2006 from the file history for U.S. Serial No. 10/663,179; these items should have been forwarded to Examiner Pollicoff in Group Art Unit 3724.

CONCLUSION

For all of the above reasons, Applicants respectfully submit that the present application is in condition for allowance. If the Examiner has any questions regarding the application or this response, the Examiner is encouraged to call Applicants' attorney, Ian F. Burns, at (775) 826-6160.

Respectfully submitted,

/ian f burns/

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